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LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			EXAMINER GARCIA, ERNESTO	
			ART UNIT 3679	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/019,195	<b>Applicant(s)</b> HANNIG ET AL.	
	<b>Examiner</b> Ernesto Garcia	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007 and 07 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 33-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-44 is/are rejected.
- 7) ☒ Claim(s) 33-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Drawings***

The drawings were received on October 10, 2007. These drawings are acceptable; however, not all drawing objections have been overcome. Further, the drawings still contain discrepancies.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate a fastening system with a first configuration of the projection profiles (Figures 1 and 2) and another fastening system with a second configuration of the projection profiles (Figure 3). Applicant argues that "a system is combination of parts forming a unitary whole" and that the invention comprises complementary retaining profile" on the edges of the panels". This is not found persuasive since the rule does not have an exception for complementary parts. Accordingly, these two projecting profiles are still different from each other and must be designated with different reference characters. Only the same identical parts get the same reference characters. The different embodiment shown in Figure 3 is a modification. See MPEP 608.02(e).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate a floor covering with two panels having each a first configuration of projection profiles in the narrow sides (Figure 2), a floor covering with two panels having each a second configuration of projection profiles in the narrow sides (Figures 6-12), and a floor covering with one panel having profiles as shown in Figure 6 in the narrow sides (see page 14, line 12) and profiles as shown in Figure 2 in the long sides. Applicants argue that reference character "1" designates a floor covering and that the floor covering may include several panels and the retaining profiles of the panels may have different embodiments. This is not found persuasive. First, applicant has admitted that the panels are different embodiments. Second, it is clear that the panels are not the same. Only the same identical panel gets the same reference characters. Accordingly, the different floor coverings must be designated with different reference characters. See MPEP 608.02(e).

Applicants further remark that the examiner is confused since there are four narrow edges, which two are long and two are short. In response, applicant should note that this description is incorrect and provided as new matter since a long edge does not constitute a narrow edge or side. Accordingly, the panels are rectangular (see page 13, line 30) with two narrow sides and two wide sides or long sides. Applicant further remarks that the profiles in Figure 6-12 are in the long side. In response, it should be noted that the long side, the applicants are referring to, is the narrow side (see page 14,

lines 11-12, and page 18, line 11) as the profiles 40 and 41 are in the narrow side. Apparently, the other panels 4,5 show the profiles on the narrow side as well (see page 9, lines 22-24). This establishes that the panels or the floor covering are not the same. Furthermore, it should be noted that the panels shown in Figure 6 do not have any profiles on the wide sides. Therefore, the panels are not the same to be designated the same reference character "1".

The drawings are objected to because the panel 41 in Figure 6 shows a portion that is cut-off in cross-section and should be cross-hatched.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The amendments filed on May 7, 2007 and June 16, 2004 are objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35

U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

On the amendment filed on May 7, 2007, the recitation "and four narrow sides around the edges of the panel" on the seventh paragraph starting on line 16 of page 9 is nowhere found in the original disclosure. Applicants cannot rely on Figure 13 since such figure is not an original figure. Figure 13 is a new figure which is not supported as originally filed. Further, this description provides new matter for a panel that is square rather than being rectangular as described on page 13, line 30; and,

On the amendment filed on June 16, 2004, Figure 13 is still new matter along with the description of Figure 13 that the profiles of Figure 2 and the profiles of Figure 6 are in one panel, and the description of four narrow sides wherein two are long sides. Nowhere is there support that indicates that the profiles 42 and 43 are along the wide sides as well as the profiles 4a and 4b being on the narrow sides. According to the original disclosure, the profiles 42 and 43 are in the narrow sides (see original

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disclosure at page 15, lines 9, 23, 24, and 30) in one species and the profiles 4a and 4b are in the same narrow sides in another species (see original disclosure at page 11, line 22). This is also evident by the amendment to the description of Figure 13 filed on March 9, 2005. Here, the description is inaccurate and unsupported because a rectangular does not have four narrow sides but rather two narrow sides and two wide sides. Furthermore, according to the specification, the profiles 4a and 4b are in the narrow sides, i.e., the long sides of the rectangle according to convention, and not in the short sides of the rectangle as applicants are intending to describe.

Applicants further indicate that the applicants can be their own lexicographer and that the definition of "narrow side" does not mean as short side. In response, where is this definition being defined in the original specification? Note that the applicants do not make reference to the specification by page and line number. Applicants further remark that the "narrow side" refers to all four edges around the rectangle. In response, note that no such description is found in the disclosure and four narrow sides apparently define a square and not a rectangle. The specification merely recites "long narrow side" which is apparently an error that needs to be corrected since a narrow side does not constitute a long side but rather a short side. Further, the examiner is not going to allow definitions that are against convention in particular when a rectangle is well known to have two short sides and two long sides, or, alternatively, two wide sides and two narrow sides. Applicants cannot rely on the last paragraph of page 18 since that is, by

itself, the new matter at issue. Applicants are required to cancel the new matter in the reply to this Office Action.

The disclosure is objected to because of the following informalities:

The description "long narrow sides" on page 4, line 29, page 5, line 2, page 9, lines 11-12, page 13, lines 30-31, and page 17, line 8, is an oxymoron and should be corrected; Note that "long" contradicts "narrow" since being long does not constitute being narrow but wide; and,

The description "short narrow sides" on page 6, lines 24 and 25, page 12, line 26, and page 17, line 6 should be shorted to "narrow sides" since narrow inherently involves being short. Further, relative to what is narrow being defined? According to the last paragraph on page 13, the panels are rectangular. Appropriate correction is required.

### ***Claim Objections***

Claims 33, 36, 39, and 42 are objected to because of the following informalities:

regarding claims 33 and 39, "its" in lines 12 and 17 should be defined; and,

regarding claims 36 and 42, --second-- should be inserted before "hook" in line 2, and --first-- should be inserted before "hook" in line 3. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.



***Claim Rejections - 35 USC § 112***

Claims 33-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 33, the meets and bounds of the claim is unclear. The recitations "a first panel" in lines 3-4, and "a second panel" in line 4-5 make unclear whether these are the same two panels recited in line 1 or the same panels. The recitations "the panel" in lines 10, 14, 22, 23-24, 26, and 27, and "said panel" in lines 11 and 15, make unclear whether the panel is the first panel or the second panel. The recitation "the hook projection" in lines 22 and 25 makes unclear whether that is the first or second projection. The recitation "the leg" in line 22, 23, 26, and 27 make unclear whether this is the first leg or the second leg. Further, the description "that can be hooked one into the other" in line 9 is misdescriptive since the complementary hook elements of the first panel hook with the similar retaining profiles of the second panel and not with each other.

Regarding claim 34, the recitation "first hook element" in line 3 and "second hook element" in line 9 makes unclear whether these are different hooks than the first hook projection and the second hook projection respectively recited in claim 33, lines 10 and 14, or the same hooks. If the hooks are the same, this will render the hooks, formed

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from either the first leg and the second leg, redundant since claim 33 already mentions that the hook projections are respectively made by the first leg and the second leg.

Regarding claim 36, the recitation "in the assembled condition bears against the second panel" in lines 3-4 is unclear. Note that using the language "assembled condition" is redundant since claim 33, line 18, already stated this condition. Further, the clause appears as a run-on sentence.

Regarding claims 39, 40, and 42, the same ambiguities stated above apply to these claims according to claims 33, 34, and 36, respectively.

Regarding claims 35, 37, and 38, the claims depend from claim 33 and therefore are indefinite.

Regarding claims 41, 43, and 44, the claims depend from claim 39 and therefore are indefinite.

### ***Allowable Subject Matter***

Claims 33-44 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 33, the prior art of record does not disclose or suggest a system comprising a first panel and a second panel having at least one pair of oppositely disposed retaining profiles having complementary hook elements comprising a first hook projection and a second hook projection each having an inclined retaining surface (lines 11-12 and 16) such that the hook projection is reduced from a free towards a leg (lines 12-13 and 16-17) in combination with, as best understood, a space provided between the first hook projection and the second leg (lines 25-28) of the second panel. The closest prior art, French patent, FR-2278876, teaches the inclined retaining surfaces and the reduced hook projections from the free end towards the leg. However, there's no evidence that there's a space since the hook projections engage with each other. Further, there's no motivation to provide a space since the space makes the panels loose with respect to each other;

regarding claim 39, the prior art of record does not disclose or suggest a system comprising a first panel and a second panel having at least one pair of oppositely disposed retaining profiles having complementary hook elements comprising a first hook projection and a second hook projection each having an inclined retaining surface (lines 11-12 and 16) such that the hook projection is reduced from a free towards a leg (lines 12-13 and 16-17) in combination with, as best understood, a space provided between the second hook projection and the first leg (lines 25-28) of the first panel. The closest prior art, French patent, FR-2278876, teaches the inclined retaining surfaces

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and the reduced hook projections from the free end towards the leg. However, there's no evidence that there's a space since the hook projections engage with each other. Further, there's no motivation to provide a space since a space makes the panels loose with respect to each other. Zancai, WO00/63510, teaches the claimed invention in Figure 8; however, Zancai, is not prior art as the subject matter claimed is supported on the PCT application;

regarding claims 34-38, these claims depend from claim 33; and,

regarding claims 40-44, these claims depend from claim 39.

### ***Response to Arguments***

Applicants' arguments with respect to claims 33-44 have been considered but are moot in view of the new ground(s) of rejection. In particular, note the 35 USC 112 2<sup>nd</sup> paragraph, rejections.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

*E.G.*

E.G.

January 3, 2008

*Daniel P Stodola*

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600